

Application No. 09/998,092
Response to May 20, 2004 Office action

REMARKS

Claims 1-86 were originally pending. Claim 5 has been amended. Claims 10-23, 33-45, and 55-86 were canceled without prejudice as being directed to non-elected (withdrawn) subject matter. Accordingly, claims 11-9, 24-32, and 46-54 remain pending.

Amendments to the Specification

The Office Action ("Action") at page 2, section 3, asserts that the title is not descriptive and that a new title is required that is clearly indicative of the invention to which the claims are directed.

It is respectfully submitted that "Media Agent" clearly describes the systems and methods of the invention in a small number of broad terms in accordance with 37 CFR §1.72(a). However, to comply with the Examiner's request, a new title has been supplied to indicate further details of the systems and methods of the invention. This new title is: "A Media Agent to Suggest Contextually Related Media Content".

In the specification, Applicant has also amended errors in punctuation. In each correction, a blank space before the end-of-line period was removed.

35 USC §112, First Paragraph

Claims 1-9, 24-32, 46-54 stand rejected under 35 USC §112, first paragraph as failing to comply with the written description requirement. The Action asserts that the claims include subject matter not described in the specification in such a way as to reasonably convey to one of skill in the art that the inventors had possession of the claims invention. This rejection is traversed.

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Although the CCPA has stated that the written description requirement is relatively simple to comply with and will ordinarily demand minimal concern on the part of the Patent Office, the Office bears the initial burden of establishing a prima facie case of lack of written description. A prima facie case of lack of written description includes the following elements: (a) an application does not reasonably describe or convey the concepts (b) to one of ordinary skill in the art (c) at the time of filing the patent application of the claimed invention. If even one of these elements is not present, the rejection is improper and must be withdrawn.

Claim 1 recites "detecting user input", "analyzing the user input", "predicting desired access to one or more media files based on the analysis", "retrieving information corresponding to one or more media files from a media content source", and "presenting the information to a user for suggested access."

In addressing claim 1, the Action concludes that the specification lacks sufficient written description based on the Examiner's analysis of page 16, lines 21-23 of the specification. This portion of the specification recites "[t]he prediction module 216 may determine or predict that a user desires to use/insert a media file into a document based on what a user types". In view of this recited portion, the Action asserts that the specification does not support the claimed "predicting desired access to one or more media files based on the analysis", but instead only supports "predicting the desire to insert a media file". Applicant disagrees.

Referring to the first prima facie element "(a)" required to support a prima facie case of lack of written description, an application need not contain a word-for word description of the claimed invention to satisfy the written description requirement (MPEP §2173.05(i)). All that is required is that the application

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reasonably convey the subject matter. The subject specification clearly describes and conveys the claimed "predicting desired access to one or more media files based on the analysis", as recited by claim 1. First, let's refer to that portion of the specification referred to by the Action.

Page 16, lines 21-23, the specification recites "[t]he prediction module 216 may determine or predict that a user desires to use/insert a media file into a document based on what a user types". It is respectfully submitted, that a user cannot use or insert a media file into a document without first accessing it. For at least this reason, predicting a desire to use or insert a media file into a document necessarily includes "predicting desired access to one or more media files". Thus, the portion of the specification referred to by the Action does reasonably describe and convey the concepts of "predicting desired access to one or more media files", as claim 1 recites.

Moreover, other portions of the specification also clearly describe and convey that the term "access" refers to more than just file insertions. Page 2 lines 18-20 recites: "The described arrangements and procedures provide a media agent to detect and analyze inserted text. Based on the analysis, the media agent predicts or anticipates whether a user intends to access media content." Examples of such "access" are provided at page 6, lines 13-18: "This electronic exchange provides for client 102 communication with media content store 104 to access (e.g., view, search, download, etc.) pieces of media content 106." Other exemplary uses to show exemplary user "access" of media content is provided at page 32, lines 5-8: "Trigger 310 shows that the on-line crawler is activated by user actions 312 such as accessing the Web 302, e-mails 304, documents or Web pages 306, file folders 308, user 'save-as' actions 316, browsing 318, text insertion 320, media insertion

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321, and so on.” At page 36, lines 20-22 the specification recites “it is determined if the action corresponds to user access of a URL, opening of a media file, or downloading a file (e.g., saving a file).” Moreover, at page 38, lines 21-24, the specification recites: “At block 602, the procedure 400 determines if the user action (block 402) is an explicit user search for a media object, an object insertion action, or action corresponding to a document edit (e.g., e-mail, a word-processing document, etc.)”.

In view of the above, the specification not only describes and conveys concepts of “predicting the desire to insert a media file” as asserted by the Action, but the specification also clearly describes and conveys concepts of “predicting desired access to one or more media files”, wherein the access is related to a user’s desire to search, edit, browse, search, download, save, insert a file into document, etc., etc., wherein the described types of access have been presented merely as examples of the many different types of user access that may be predicted by the systems and methods of the invention.

For these reasons alone, the first element “(a)” of a prima facie 35 USC §112, first paragraph rejection has not been shown with respect to claim 1. Accordingly, and for these reasons alone, the 35 USC §112, first paragraph rejection of claim 1 is improper and should be withdrawn.

Claims 2-9 depend from claim 1 and are allowable by virtue of this dependency.

Claims 24, 46, and 54 also include the recited feature of “predicting desired access to one or more media files based on the analysis”. For the reasons already discussed above with respect to claim 1, the first element “(a)” of a prima facie 35 USC §112, first paragraph rejection has not been shown with respect to these

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claimed features. Accordingly, and for these reasons alone, the 35 USC §112, first paragraph rejection of claims 24, 46, and 54 are also improper and should be withdrawn.

Claims 25-32, and 46-53 depend from respective ones of these claims and are allowable by virtue of this dependency.

35 USC §112, Second Paragraph

Claim 5 stands rejected under 35 USC §112, second paragraph being indefinite for failing to particularly point out and claim subject matter of the invention. In particular, the Action points out that the limitation “the text” and “the one or more keywords” in claim 5 lack antecedent basis. Applicant has amended claim 5 to provide the term “text” with antecedent bases. With respect to the phrase “the one or more keywords” on line 3 of claim 5, this phrase has antecedent basis in line 2 of the claim wherein “determining one or more keywords” is recited.

In view of this amendment and upon the showing of antecedent basis for the indicated second phrase, Applicant trusts that the 35 USC §112, second paragraph rejection of claim 5 will be withdrawn.

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Conclusion

Pending claims 11-9, 24-32, and 46-54 are in condition for allowance and action to that end is respectfully requested. Should any issue remain that prevents allowance of the application, the Office is encouraged to contact the undersigned prior or issuance of a subsequent Office action.

Respectfully Submitted,

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Respectfully Submitted,